

REMARKS/ARGUMENTS

Art Rejections

1. Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Hidary, U.S. Patent No. 5,852,775 ("Hidary"). Claim 1 is an independent claim. Applicant respectfully traverses this rejection for at least the reasons stated below.

To be an "anticipation" rejection under 35 U.S.C. § 102, the reference must teach every element and recitation of the Applicants' claims. Rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art. Thus, the reference must clearly and unequivocally disclose every element and recitation of the claimed invention.

Applicant respectfully submits that Hidary fails to disclose at least the following recitation of independent claim 1:

a switching center coupled to the telecommunications advertising means, the switching center configured to route communications between the terminals, to route communications from the terminals to fixed network users via the fixed network interface, to route *in place of ring tones of a ringback signal*, advertisements associated with a source of the incoming communication by the telecommunications advertising means to a terminal associated with the source, and to route advertisements associated with a destination of the incoming communication by the telecommunications advertising means to a terminal associated with the destination.

Hidary is directed to a cellular telephone system which selectively delivers advertisements to cellular subscribers (*See Col. 1, lines 20-23*). Specifically, while a call

connection between a subscriber and a third party is being established, the subscriber hears a short commercial message (*See Col. 1, lines 56-60*). Once the call is established and upon completion of the commercial message, the subscriber hears either a standard ringback signal or a busy tone depending on the state of the third party's equipment (*See Col. 3, lines 29-37*). In other words, upon placing a call, the subscriber is first exposed to a commercial message. The subscriber then hears the standard ringback signal of the third party upon completion of the message.

As such, Hidary is different from the claimed subject matter in that Hidary merely places a commercial message before standard phone operations, such as connection of a standard ringback signal to a calling party. The claimed subject matter on the other hand, replaces the ring tones of a ringback signal with selected advertisements (see, e.g., page 7, lines 26-30). Hidary clearly does not describe replacing ring tones with advertisements and thus does not disclose each and every recitation of the independent claim 1. The Examiner is therefore respectfully requested to withdraw the § 102 rejection from independent claim 1.

2. Claim 2 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hidary as applied to claim 1, and further in view of Bryant, Jr., U.S. Patent No. 3,684,834 ("Bryant"). Claim 2 depends from independent claim 1. Hidary is deficient with respect to claim 1 for at least the reasons stated above. Therefore, the Examiner must rely on Bryant to compensate for the foregoing deficiencies.

Bryant is drawn to an apparatus for remotely changing the message of an automatic announcing machine (*See e.g., Title*). More specifically, an encoding apparatus is provided for

coding dialed information representative of a desired change in an announcement's format from a remote telephone network (*See Col. 1, lines 27-31*). Bryant, however, fails to disclose replacing ring tones with advertisements as recited in independent claim 1. Applicant therefore submits that claim 2 is patentable at least by virtue of its dependency and the Examiner is respectfully requested to withdraw the § 103(a) rejection.

3. Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hidary, as applied to claim 1 above, and further in view of Farris et. al. U.S. Patent No. 6,151,491 ("Farris"). Claim 3 depends from independent claim 1. Hidary is deficient with respect to claim 1 for at least the reasons stated above. Therefore, the Examiner must rely on Farris to compensate for the foregoing deficiencies.

Farris is directed to a mobile voice message and electronic mail system (*See e.g., Title*). Farris, however, fails to disclose the above identified recitations with respect to independent claim 1. Therefore, Applicant submits that claim 3 is patentable at least by virtue of its dependency. The Examiner is therefore respectfully requested to withdraw the § 103(a) rejection.

4. Claims 4 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hidary as applied to claim 1 above, and further in view of Owensby, U.S. Publication No. US2002/0077130 ("Owensby"). Claims 4 and 9 ultimately depend from independent claim 1. Hidary is deficient with respect to claim 1 for at least the reasons stated above. Therefore, the Examiner must rely on Owensby to compensate for the foregoing deficiencies.

Owensby is directed to a system and method for providing targeted messages based on wireless mobile location (*See e.g., Title*). More specifically, Owensby describes in detail how call signal information is used to determine the location of the wireless subscriber thus allowing a database/server to associate/transmit location appropriate advertisements to the subscriber. Although Owensby is directed to advertising via a telecommunication system, Owensby does not disclose, teach or suggest replacing ring tones with advertisement and therefore does not compensate for the deficiencies of Hidary with respect to independent claim 1. Applicant therefore respectfully submits that claims 4 and 9 are patentable at least by virtue of their dependency. In summary, the Examiner is requested to withdraw the § 103(a) rejection from claim 4 and 9.

5. Claims 5-7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hidary in view of Owensby, as applied to claim 4 above, and further in view of Ogasawara, U.S. Patent No. 6,512,919 ("Ogasawara"). Claims 5-7 ultimately depend from independent claim 1. The combination of Hidary and Owensby are deficient with respect to claim 1 for at least the reasons stated above. Therefore, the Examiner must rely on Ogasawara to fulfill at least these deficiencies.

Ogasawara is directed to an electronic shopping system utilizing a program downloadable wireless videophone (*See e.g., Title*). The program is downloaded onto a subscriber's wireless videophone thus transmitting the videophone into a dedicated terminal enabling a shopper to capture and decode images (*See Col. 1, lines 16-21*). There is, however, absolutely no disclosure or discussion of replacing ring tones with advertisement in Ogasawara. Therefore, the

combination of Hidary, Owensby and Ogasawara, either taken alone or in combination, fails to disclose, teach or suggest each recitation of independent claim 1. Applicant thus submits that claims 5-7 are patentable at least by virtue of their dependency and the Examiner is requested to withdraw the § 103(a) rejection from the claims.

6. Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hidary in view of Owensby and in further view of Ogasawara as applied to claim 6 above, and further in view of Baker, U.S. Patent 6,505,046 ("Baker"). Claim 8 depends from claim 6 which ultimately depends from independent claim 1. The combination of Hidary and Owensby is deficient with respect to claim 1 for at least the reasons discussed above. Therefore, the Examiner must rely on Baker to fulfill at least these deficiencies.

Baker is drawn to a method and apparatus for distributing location-based messages in a wireless communication network (*See e.g., Title*). More specifically, in Baker a subscriber dials a predetermined number to learn about special retail offers (*See Abstract*). The network derives location information from the subscribers call signal and then transmits, via SMS, appropriate advertisement to the subscriber based on their location (*See Col. 1, lines 37-55*). Baker, however, fails to disclose, teach or suggest replacing ring tones with advertisements as clearly recited in independent claim 1. Therefore, Applicant submits that claim 8 is patentable at least by virtue of its dependency. The Examiner is respectfully requested to withdraw the § 103(a) rejection.

7. Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hidary in view of Owensby, as applied to claim 4 above, and further in view of Farris. Claim 10

depends from claim 4 which ultimately depends from independent claim 1. The combination of Hidary and Owensby is deficient with respect to claim 1 for at least the reasons stated above. Therefore, the Examiner must rely on Farris to fulfill at least these deficiencies.

As described above, Farris is drawn to a mobile voice message selection system architecture for selecting and receiving voice/electronic mail messages from external systems (*See Col. 1, lines 20-22*). Farris, however, fails to disclose the above identified recitations with respect to independent claims 1 and 14. Therefore, Applicant submits that claims 5, 6, 9, 18, 19 and 23 are patentable at least by virtue of their dependency. The Examiner is therefore respectfully requested to withdraw the § 103(a) rejection.

8. Claim 11 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hidary in view of Owensby and in view of Farris, as applied to claim 10 above, and in further view of Baker U.S. Patent No. 6,505,046 ("Baker"). Claim 11 ultimately depends from independent claim 1. The combination of Hidary, Owensby and Farris is deficient with respect to claim 1 for at least the reasons stated above. Therefore, the Examiner must rely on Baker to fulfill at least these deficiencies.

Baker is directed to a process that enables restaurants and retail establishments to advertise in real time to local customers (*See Col. 1, lines 37-38*). Baker, however, also fails to disclose, teach or suggest replacing ring tones with advertisements as clearly recited in independent claim 1. Therefore, Applicant submits that claim 11 is patentable at least by virtue of its dependency. The Examiner is therefore respectfully requested to withdraw the § 103(a) rejection.

9. Claim 12 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hidary in view of Ownesby, as applied to claim 4 above, and further in view of Dowling et al., U.S. Patent No. 6,522,875 ("Dowling"). Claim 12 ultimately depends from independent claim 1. The combination of Hidary and Owensby is deficient with respect to claim 1 for at least the reasons stated above. Therefore, the Examiner must rely on Dowling to fulfill at least these deficiencies.

Dowling is directed to a geographical web browser which allows users to navigate a set of network web pages based on a user's location and the setting of one or more auxiliary control parameters (*See Col. 1, lines 7-11*). In other words, Dowling enables a user to "surf the web" or navigate a network application program based on geographically related information (*Col. 4, lines 63-65*). Dowling, however, fails to disclose, teach or suggest at least replacing ring tones with advertisements as recited in independent claim 1. Therefore, Dowling fails to compensate for the deficiencies of Hidary and Owensby thereby rendering claim 12 patentable at least by virtue of its dependency. Thus, the Examiner is requested to withdraw the § 103(a) rejection.

10. Claims 13 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hidary and further in view of Ogawa et al., U.S. Patent No. 4,88,865 ("Ogawa"). Claims 13 and 14 ultimately depend from independent claim 1. Hidary is deficient with respect to claim 1 for at least the reasons stated above. Therefore, the Examiner must rely on Ogawa to fulfill at least these deficiencies.

Ogawa is directed to a terminal switching control apparatus which automatically switches between a telephone and facsimile in accordance with a communication mode requested by a

caller upon detecting a calling signal (*See Col 2, lines 13-18*). Like Hidary, Ogawa also fails to disclose the above identified recitations with respect to independent claim 1. Therefore, Applicant submits that claims 13 and 14 are patentable at least by virtue of their dependency. The Examiner is therefore respectfully requested to withdraw the § 103(a) rejection.

11. Claims 15 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hidary in view of Hymel et al., U.S. Patent No. 6,157,814 ("Hymel"). Claims 15 and 16 ultimately depend from independent claim 1. As discussed above, Hidary is deficient with respect to claim 1 for at least the reasons stated above. Therefore, the Examiner must rely on Hymel to fulfill at least these deficiencies.

Hymel is directed to a wireless subscriber unit and method for presenting advertisements as a message indicator (*See e.g. Title*). An advertisement manager is programmed to assign an advertisement icon to a message indicator on the display of a wireless subscriber's unit (*See Abstract*). Hymel, however, fails to disclose, teach or suggest replacing a ring tone with an advertisement as claimed in independent claim 1. Therefore, Applicant submits that claims 15 and 16 are patentable at least by virtue of their dependency. The Examiner is therefore respectfully requested to withdraw the § 103(a) rejection.

12. Claim 17 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hidary in view of Dowling. Claim 17 is an independent claim. Applicant respectfully traverses this rejection as set forth below.

Applicant submits that the combination of Hidary and Dowling fails to disclose, teach or suggest at least the underlined recitation of claim 17:

a packet data server configured to interface the terminals with the Internet, to route communications between the terminals and the Internet over the packet data carrier, and to route, *in place of connection tones in a ringback signal*, advertisements associated with a source of the incoming packet data communication to the source, and to route advertisements associated with a destination of the incoming packet data communication to the destination.

As described in detail above, Hidary actually teaches away from the claimed subject matter. Hidary does not replace ring tones with advertisements but rather subjects the subscriber to an advertisement prior to engaging conventional phone operations, such as ringing the called party (*See Col. 3, lines 29-35*). As such, the subscriber in Hidary first hears a commercial message and when the commercial is complete the standard ringing begins.

Furthermore, Dowling fails to compensate for the deficiencies of Hidary in that Dowling merely enables a user to "surf the web" or navigate a network application program based on geographically related information (*Col. 4, lines 63-65*). Dowling clearly does not disclose, teach or suggest replacing connection tones in a ringback signal with advertisements.

Without at least such a suggestion, one would not have been (and could not have been) motivated to combine the cellular telephone advertising system, as disclosed in Hidary, with the geographical web browser, as taught in Dowling, to produce the claimed subject matter. Because there can be found in Dowling no teaching or suggestion that meets the above-identified recitations, the combination of Hidary and Dowling cannot reasonably be said to render obvious the claimed subject matter. The Examiner is therefore respectfully requested to withdraw the § 103(a) rejection from independent claim 17.

13. Claim 18 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hidary in view of Dowling and in further view of Owensby. Claim 18 depends from independent claim 17. The combination of Hidary and Dowling is deficient with respect to claim 17 for at least the reasons stated above. Therefore, the Examiner must rely on Owensby to fulfill at least these deficiencies.

As described above, Owensby is directed a system for providing targeted messages based on wireless mobile locations. Like Hidary and Dowling, Owensby also fails to disclose, teach or suggest replacing connection tones with advertisements as recited in independent claim 17. Therefore, Applicant submits that claim 18 is patentable at least by virtue of its dependency. The Examiner is therefore respectfully requested to withdraw the § 103(a) rejection.

14. Claims 19, 20 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hidary and in view of Dowling and Owensby and further in view of Ogasawara. Claims 19-21 ultimately depend from independent claim 17. The combination of Hidary, Dowling and Owensby are deficient with respect to claim 17 for at least the reasons stated above. Therefore, the Examiner relies on Ogasawara to fulfill at least these deficiencies.

For the reasons stated above which are fully incorporated herein, Applicant submits that Ogasawara fails to disclose, teach or suggest replacing connection tones with advertisements. As such, Ogasawara does not compensate for the deficiencies of the combination of Hidary, Dowling and Owensby with respect to independent claim 17. Therefore, Applicant submits that claims 19-21 are patentable at least by virtue of their dependency. The Examiner is therefore respectfully requested to withdraw the § 103(a) rejection.

15. Claim 22 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Hidary in view of Dowling, Owensby and Ogasawara and in further view of Baker. Claim 22 ultimately depends from claim 17. The combination of Hidary, Dowling, Owensby and Ogasawara fails to disclose each recitation of independent claim 17. Therefore the Examiner must rely on Baker to fulfill at least these deficiencies.

Because Baker fails to disclose, teach or suggest replacing connection tones with advertisements, Baker fails to compensate for the deficiencies of Hidary, Dowling, Owensby and Ogasawara. Therefore Applicant submits that claim 22 is patentable at least by virtue of its dependency. The Examiner is therefore respectfully requested to withdraw the § 103(a) rejection.

16. Claim 23 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hidary and in further view of Owensby. Claim 23 is an independent claim. Applicant respectfully traverses this rejection for at least the reasons stated below.

Applicant respectfully submits that the combination of Hidary and Owensby does not disclose, teach or suggest, when taken alone or in combination, the following recitation of independent claim 23:

playing or otherwise displaying the one or more advertisements, *in place of ring tones of a ringback signal*, through a terminal associated with the source or destination of the communication prior to connecting the source to the destination for purposes of completing the communication; and

As discussed above, Hidary teaches away from the claimed subject matter. Specifically, Hidary discloses that subscriber 16 first hears the selected advertisement, then upon completion of the commercial message, the subscriber hears either a standard ring or a busy signal (*See Col. 3, lines 29-35*). Hidary clearly does not disclose replacing ring tones with advertisements as recited by independent claim 23.

Owensby does not compensate for the deficiencies of Hidary because Owensby also fails to disclose replacing ring tones in a ringback signal with advertisements. Rather, Owensby is directed to a system for inserting commercial information into a wireless mobile communication, wherein the commercial information is targeted to the subscriber on the basis of wireless mobile location information gleaned from the calling signal (*See Col. 6, ¶ 0032*). Owensby describes in detail how call signal information is used to determine the location of the wireless subscriber thus allowing a database/server to associate/transmit location appropriate advertisements to the subscriber. Although Owensby is directed to advertising via a telecommunication system, Owensby fails to disclose, teach or suggest replacing ring tones with advertisement.

Without at least such a suggestion, one would not have been (and could not have been) motivated to combine the cellular telephone advertising system, as disclosed in Hidary, with the method for providing targeted messages, as taught in Owensby, to produce the claimed subject matter. Because there can be found in Owensby no teaching or suggestion that meets the above-identified recitations, the combination of Hidary and Owensby cannot reasonably be said to render obvious the claimed subject matter. The Examiner is therefore respectfully requested to withdraw the § 103(a) rejection from independent claim 23

17. Claims 24-25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hidary in view of Owensby and in further view of Ogasawara. Claims 24-25 depend from independent claim 23. The combination of Hidary and Owensby fails to disclose each recitation of independent claim 23. Therefore the Examiner must rely on Ogasawara to fulfill at least these deficiencies.

Ogasawara is drawn to an electronic shopping system which facilitates purchasing transactions over a wireless videophone (*See Abstract*). In short, Ogasawara has nothing to do with advertising in a wireless communication system. Moreover, Ogasawara fails to disclose, teach or suggest replacing ring tones with advertisements. The combination of Hidary, Owensby and Ogasawara therefore fails to disclose, teach or suggest each and every recitation of independent claim 23. As such, claims 24-25 are patentable at least by virtue of their dependency.

Applicant respectfully requests the Examiner to withdraw the § 103(a) rejection from claims 24-25.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

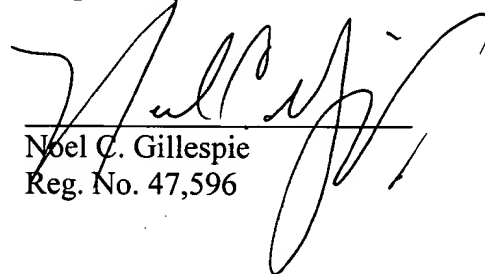
CONCLUSION

Based on the above amendments and remarks, Applicants believe that the claims are in condition for allowance and such is respectfully requested.

After the above Amendments, claims 1, 3-33 are still pending in the application, of which claims 1, 17, 23, and 29 are independent claims. Thus, there are 32 total claims and 4 independent claims. Prior to the above amendments, there were 25 total claims and 3 independent claims. Therefore, the fee for 8 additional claims and 1 additional independent claim are believed due.

Accordingly, enclosed is a check for \$590.00 to include the three-month extension of time. The Commissioner is hereby authorized to charge any additional fees required by this response to our Deposit Account No. **50-2613** (Order No. 45391.00003.CIP1.P1068).

Respectfully submitted,



Noel C. Gillespie
Reg. No. 47,596

PAUL HASTINGS JANOFSKY & WALKER LLP
CUSTOMER NUMBER 36183
P.O. Box 92191
San Diego, CA 92191-9092
Telephone: (858) 720-2500
Facsimile: (858) 720-2555